REMARKS

I.   Introduction

The Office Action dated September 21, 2005, has been carefully reviewed and the following remarks are submitted in response thereto. Claims 1-10 and 12-14 are pending in the application.

II.   Rejection of Claims 1-10 and 12-14 under 35 USC 103(a)

Claims 1-10 and 12-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Real* (Real Jukebox Plus Manual) in view of Seo et al. (U.S. Patent Application Publication 2004/0010415). Applicant respectfully traverses this rejection in light of the following arguments.

The final rejection fails to establish a case of prima facia obviousness. The references are misconstrued. Improper hindsight is substituted for the motivation to combine references.

Regarding *Real*, the Response to Arguments section of the final rejection opines that:

> Organizing songs in a particular order in which the user would like to listen is another implementation that a typical user may prefer. To accomplish these implementations, numbering the tracks in order of playback would be required for the play list type implementation and sub numbers would be required for the album type implementation.

The factors being argued by the final rejection are irrelevant and are not in accord with what is actually claimed. Claim 1 recites a directory-based file system and a dual numbering scheme for tracks including 1) a flat-file selection number which assigns numbers without regard to the directory in which the tracks are stored, and 2) an in-directory selection number for display with a directory number for the directory in which the track is stored. Thus, the numbers assigned in the present invention are not representative of a desired order of playback as the final rejection seems to suggest.

Claims 1 and 9 recite that the user searches for a track in either the flat file

mode or the directory mode. Scanning of a media (e.g., compact disc) converts a directory-based file system into a simple interface allowing the user to select tracks in either of these two modes wherein tracks can be navigated to sequentially. *Real* lacks this combination of these two particular selection modes.

Regarding Seo, any file numbering associated with the searching database is used internally by the apparatus and is not displayed or otherwise available to the user. There is no suggestion of using numbers as the basis for selection by the user. Instead, the user searches by keyword. Therefore, the combination of Seo with *Real* would not result in a device that displays track directory numbers. Furthermore, the database of Seo does not assign flat-file numbers which strip away directory information. The references lack any teaching or suggestion of simultaneously representing the tracks using a flat-file number and an in-directory number. Therefore, the teachings of the references fall well short of the claimed elements.

Regarding the lack of motivation to combine references, the Response to Arguments states:

> Implementing the numbering method disclosed by Seo in the database disclosed by *Real* would in fact speed up searching and playback in certain situations.

This argument ignores what is required for showing motivation to combine references. Assuming that a rejection cites references that do in fact contain the elements of an invention, the finding of an advantage to the combination merely confirms that the invention has a benefit. It does not, however, demonstrate that such a potential advantage would have been apparent to one skilled in the art without knowledge of the present specification.

As recently reaffirmed by the CAFC in <u>Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.</u>, 04-1493 (2005), section 103 requires some suggestion or motivation, <u>before the invention itself</u>, to make the new combination. The present invention utilizes a dual mode numbering scheme for searching for tracks such that the numbers can be displayed using a display with only a few characters. The final rejection attempts to combine 1) a PC-based display of *Real* having a nearly unlimited

number of characters with 2) an internal database file representation of Seo that is not seen by the user. Nothing in the prior art itself motivates such a combination. The rejection attempts to use the invention as a roadmap to find its prior art components.

III.   Conclusion

In view of the foregoing remarks, claims 1-10 and 12-14 are now in condition for allowance. Favorable action is respectfully solicited.

Respectfully submitted,

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